

09/668,105T139**REMARKS**

Claims 26-44 are currently under considered in the subject application. It is respectfully submitted that claims 22 and 25 were withdrawn in a previous reply, and the rejection of such claims in the subject Office Action is in error. The Examiner's withdrawal of claims 32 and 33 as being drawn to a non-elected species is noted. Claim 40 has been herein amended to correct a minor informality.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Objection To the Drawings**

The drawings are objected to under 37 CFR §1.83(a). Applicant's representative has amended Fig. 4 by illustrating the lens 326 to resolve the objection. A marked up version of this Fig. is enclosed. A new set of formal drawings incorporating such changes will be filed as a separate document. Regarding the low loss transparent adhesive, it is noted such feature is illustrated in Fig. 6 at box 506. In view of at least the above withdrawal of these drawing objections is respectfully requested.

**II. Rejection of Claims 26-30, 38, 39, and 43 Under 35 U.S.C. §102(b)**

Claims 26-30, 38, 39, and 43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shepard (US Patent 3,341,711). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Shepard does not teach or suggest the claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The subject invention as claimed relates to a scan engine device with an *image sensor*, which as defined by the subject specification employs a micro-processor and an integrated circuit as part of its operation. (See Fig. 2 of drawings. See also Specification at pages 6-8.) Such aspects of applicant's claimed invention as recited in the subject claims are not disclosed or

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suggested by Shepard. Rather, Shepard has an issue date of 1967, long before image sensors with micro-processors became known, *i.e.* component 42 of Shepard is simply a *light sensitive cell* - not an *image sensor*, as in applicant's claimed invention. (See Shepard column 2, lines 63-65.)

In view of at least the above comments, it is respectfully submitted that Shepard does not anticipate or render obvious applicant's invention as recited in claims 26-30, 38, 39, and 43, and withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 26-31, 36, 38, 39, and 43 Under 35 U.S.C. §102(b)**

Claims 26-31, 36, 38, 39 and 43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ogura *et al.* (US Patent 5,825,560). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Ogura *et al.* does not teach or suggest the claimed invention.

The subject invention as claimed relates to an *image sensor* having an aperture on to which a prism is mounted. A light beam to be processed initially enters the housing thru an opening. Such beam then passes through the prism positioned on to the aperture of image sensor, and then enters the image sensor *via* the aperture. Put differently, the prism deflects light from a first path to a second path into an aperture of the image sensor. Such aspects of applicant's claimed invention as recited in the subject claims are not disclosed or suggested by Ogura *et al.* Rather and contrary to the assertions made in the Office Action, component 901 of Ogura *et al.* is an aperture of *a board* with glass member 902 for protection - not an aperture of the image sensor with a prism for deflection of a beam into a second path as in applicant's claimed invention. (See Ogura *et al.* column 9, line 55-62.)

In view of at least the above comments, it is respectfully submitted that Ogura *et al.* does not anticipate or render obvious applicant's invention as recited in claims 26-31, 36, 38, 39, and 43, and withdrawal of this rejection is requested.

### **IV. Rejection of Claims 34, 35, 37, 40-42, and 44 Under 35 U.S.C. § 103(a)**

Claims 34, 35, 37, 40-42, and 44 stand rejected under 35 U.S.C. §103(a) as being obvious over Ogura *et al.* Claims 34, 35, 37, and 40-42, and 44 depend from independent claims 26, and 38, and 43 respectively. As explained *supra*, Ogura *et al.* does not teach or suggest independent

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claims 26, 38 and 43, and this rejection should be withdrawn.

**V. Rejection of Claim 43 Under 35 U.S.C. § 103(a)**

Claims 43 stand rejected under 35 U.S.C. §103(a) as being obvious over Taniguchi *et al.* (US Patent 5,852,287). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Taniguchi *et al.* ('287) does not teach or suggest the claimed invention.

The prism of the subject invention deflects light from a *first path* entering the prism *to a second path* and into an aperture of the image sensor. Such aspects of applicant's invention as recited in independent claim 43 is not disclosed or suggested by Taniguchi *et al.* ('287). Rather, Taniguchi *et al.* ('287) at Fig.1 illustrates a light beam 17 that travels through the prism 22 on to the photodiode 15 along the *same straight path* – with no deflection from a first path to a second path, as in applicant's claimed invention.

In view of at least the above comments, it is respectfully submitted that Taniguchi *et al.* ('287) does not anticipate or render obvious applicant's invention as recited in claim 43, and withdrawal of this rejection is requested.

**VI. Rejection of Claim 26, 27 and 36-38 Under 35 U.S.C. § 103(a)**

Claims 26, 27, and 36-38 stand rejected under 35 U.S.C. § 103(a) as being obvious over Taniguchi *et al.* ('287) as applied to claim 43 above, and further in view of Taniguchi (US Patent 5,719,389). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Taniguchi ('389) does not make up for the aforementioned deficiencies of Taniguchi *et al.* ('287) with respect to applicant's claimed invention. Accordingly, the combination of Taniguchi ('389) and Taniguchi *et al.* ('287) does not make obvious applicant's invention as recited in independent claim 26, and claims 27, 36, 37 dependent therefrom, and independent claim 38. Withdrawal of this rejection is respectfully requested.

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**CONCLUSION**

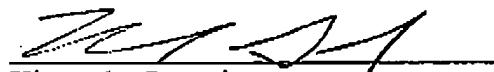
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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